

REMARKS/DISCUSSION:

This Response B is being filed within one month after the shortened statutory period for response that ended on September 25, 2009. Accordingly, a Petition for a One-Month Extension of Time is made a part of the electronic filing hereof.

By this Response B, claims 1-14 and 16-20 are pending in this application.

Amendment and/or cancellation of claims are not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, any amendments or arguments are made without conceding the correctness of any of the rejections of the pending Office Action, and Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

An RCE and IDS are being filed with this Response B.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1 and 16 stand rejected as failing to comply with the written description requirement. The Examiner states that claims 1 and 16 recite that the waveguide is positioned within the outer tube. The Examiner cites paragraph [0037] of the specification that the elongated member 150 extends through aperture 175 of the inner tube 170.

In one embodiment, an inner tube 170 is, in part, contained within an outer tube, 160. Waveguide 179 (containing blade 88) is, in part, contained within inner tube 170. See Figures 1, 4 and 5. Therefore, it follows that the

waveguide 179 is positioned within the outer tube 160 as recited in the claims. See also, Figures 6 and 7, which disclose a blade (and waveguide) in combination with a lumen contained within a single outer tube. Applicants respectfully submit that these references clearly provide substantial description of (previously amended) claims 1 and 16. Reconsideration is requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-11 and 16-20 stand rejected as being anticipated by U.S. Patent No. 5,275,607 to Lo as noted in the office action. Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. Lo fails to disclose each and every element arranged as required by the claim.

i. Lo does not disclose a lumen in an overlapping relationship with a blade

Independent claims 1 and 16 have been amended to recite:

a housing;

an outer tube having a proximal end joined to the housing, and a distal end;

a waveguide positioned within the outer tube, . . .; and

at least one lumen positioned in within the outer tube and in an overlapping relationship with the blade. (Emphasis added.)

The Examiner comments that a lumen is disposed in an overlapping relationship with the blade. (OA, pg. 3.) The Examiner, however, does not provide any support in Lo for such a statement. Figures 1-10 are of no help, since these figures only provide partial assemblies, and no firm understanding for the arrangement of the lumen relative to the blade. Figure 19, which clearly shows a lumen proximal to the blade, and actually contradicts the Examiner's statement.

ii. Lo does not disclose a lumen moveable distally or radially

Claims 4 and 19 recite "lumen is moveable within the outer tube" and "lumen is moveable", respectively. The Examiner states the lumen is moveable distally or radially and makes reference to Figs. 11a-11c. (OA, pg. 3.) Figs. 11a-11c do not disclose the lumen moveable within the outer tube. Rather, the lumen 34 of Lo is fixed as stated at col. 9, lines 1-7:

formed of 20 gauge stainless steel needle. The tube or needle 34 is fixedly secured to the bushing 32 by a pin 36, which is press fitted in aligned openings in the tube 34 and in the stationary blade member 28. As shown in the upper portion of FIG. 1, the bushing 32, the tube 34 and the stationary blade member 28 are fixedly secured together by the pin 36. To facilitate removal of the

Further, Figs. 11a-c disclose:

FIGS. 11a, 11b and 11c are schematic showings of the blade portions of the scissors of FIG. 1 showing the blades in their closed, partially opened and fully opened positions, respectively;

See, col. 8, lines 14-17.

Claims 2-11 all depend from claim 1 and claims 17-20 depend from claim 16. Without acquiescing in any way to arguments presented by the Examiner as to these claims, Applicant(s) submits that these claims are likewise patentable over Lo for at least the same reasons as discussed above with respect to claim 1 and 16, respectively, by virtue of their dependency from claims 1 and 16. Withdrawal of the rejections as to these claims is likewise requested.

Rejection under 35 U.S.C. § 103

Claims 12-15 stand rejected as being unpatentable over Lo as noted in the office action. Claims 12-15 depend from claim 1, and based upon the previous discussions, Lo, disclose or suggest the claimed invention. Reconsideration is requested.

Conclusion

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. §§ 112, 102(b) and 103 have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END0797USNP/VEK.

Respectfully submitted,

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